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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,540	06/19/2001	Odd N. Oddsen JR.	INNOFF 3.0-011	2641

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EXAMINER

WOOD, KIMBERLY T

ART UNIT PAPER NUMBER

3632

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,540

Applicant(s)

Oddsen

Examiner

Kimberly T. Wood

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-23 and 33-36 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 13, 16, 24-26, 28, and 32 is/are rejected.
- 7) ☒ Claim(s) 3-5, 7-12, 14, 15, 27, and 29-31 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jul 20, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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This is the second office action for serial number 09/884,540, Configurable Mount For A Peripheral Device, in response to Amendment A filed on June 30, 2002.

Allowable Subject Matter

The indicated allowability of claims 1, 2, 6, 13, 16, 24, 25, 26, 28, and 32 is withdrawn in view of the reference(s) to Oddsen. Rejections based on the reference(s) follow.

Specification

The specification of the disclosure is objected to because reference character "24" has been used to designate both walls and receptacle (page 9); reference characters "26" and "28" have both been used to designate bottom hole; Correction is required. See MPEP § 608.01(b).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 6, 13, 16, 24, 25, 26, 28, 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-79 of copending Application No. 09/406,531 in view of Whitlow 2,756,954. Application "531" discloses a shaft holder, a first member, a second member, openings, threaded members, and a method of mounting these elements. The "531" application discloses all of the limitations of the claimed invention except for the pins. Whitlow teaches that it is known to have pins (12). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified "531" to have included the pin for the purpose of holding/ and aligning the first member to the second member to facilitate attachment.. It would have been It would have been an obvious matter of design choice to have made the pins non-circular, since such a modification would have involved a mere change in the shape of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 13, 16, 24, 25, 26, 28, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Oddsen WIPO 00/25640 in view of Whitlow 2,756,954. Oddsen discloses a shaft holder, a first member, a second member, openings, threaded members, and a method of mounting these elements. Whitlow teaches that it is known to have pins (12). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Oddsen to have included the pin for the purpose of holding/ and aligning the first member to the second member to facilitate attachment. It would have been an obvious matter of design choice to have made the pins non-circular, since such a modification would have involved a mere change in the shape of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

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Allowable Subject Matter


Claims 3-5, 7-12, 14, 15, 27, and 29-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 17-23 and 33-36 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Wood whose telephone number is (703) 308-0539. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168. The fax number for an Official Amendment or Response is (703) 872-9326. The fax number for an Official After Final Amendment or Response is (703) 872-9327.

Kimberly Wood
Primary Examiner
November 18, 2002


KIMBERLY WOOD
PRIMARY EXAMINER